

Customer No.: 31561  
Application No.: 10/711,378  
Docket No.: 13816-US-PA

### **REMARKS**

#### **Present Status of the Application**

Claims 3 and 6 are objected to because appropriate correction in claims 3 and 6 is required. The Office Action rejected claims 1-4 and 9 under 35 U.S.C. 102(b), as being anticipated by Trojan et al. (US 5,899,798). The Office Action also rejected claims 5-8 under 35 U.S.C. 103(a) as being unpatentable over Trojan in view of Lusc et al. (US 6,486,660).

Applicants have amended claims 1, 3, 5 and 6 to more clearly define the present invention. In particular, the amendment of claim 3 is supported by the drawing of Fig. 2. The hollow portion of the ring piece is at the position near the loading component 210, such that the groove 232 is existed between the ring piece 290 and the first gasket 250. Therefore, no new matter is entered.

After entry of the foregoing amendments, claims 1-9 remain pending in the present application, and reconsideration of those claims is respectfully requested.

#### **Discussion of Office Action Objections**

Claims 3 and 6 are objected to because "wherein the inner edge of the ring piece and the first gasket consist a groove" in claim 3 and "a second gasket fixed under the heating plate which is placed between the first gasket and the second gasket" in claim 6 are not clear.

Applicant has amended "wherein the inner edge of the ring piece and the first gasket consist a groove" into "wherein the ring piece has a hollow portion such that the groove is

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existed between the ring piece and the first gasket" in claim 3, and amended "a second gasket fixed under the heating plate which is placed between the first gasket and the second gasket" into "a second gasket fixed below the heating plate, such that the heating plate is placed between the first gasket and the second gasket" in claim 6 to overcome the objection.

**Rejection under 35 U.S.C. 102 (b)**

*Applicants respectfully traverse the 102(b) rejection of claims 1-4 and 9 because Trojan et al. (US 5,899,798) does not teach every element recited in these claims.*

In order to properly anticipate Applicants' claimed invention under 35 U.S.C 102, each and every element of claim in issue must be found, "either expressly or inherently described, in a single prior art reference". "The identical invention must be shown in as complete details as is contained in the .... claim. Richardson v. Suzuki Motor Co., 868 F. 2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. 2131, 8<sup>th</sup> ed., 2001.

The present invention is in general related a mechanism for compressing chips as claim 1 recites:

Claim 1. A mechanism for compressing chips, comprising:  
a loading component;  
a head component disposed under the loading component, *wherein the head component has a heating plate therein, and a gap is existed between the loading component and the head component*; and  
a gimbal disposed between the loading component and the head component to support the gap therebetween.

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Trojan fails to teach or suggest that the gimbal is disposed between the loading component and the head component and the gimbal supports the gap between the loading component and the head component. The office action points out that the load cell shown in Fig. 7 of the citation is as the loading component of the present invention; the component 401 shown in Fig. 4A and Fig. 6 is as the head component of the present invention; and the gimbal shown in Fig. 7 and 4A is as the gimbal of the present invention. However, in Fig. 7, the gimbal 502 is disposed between the contact pin 401 and the substrate plate 600, in other words *the gimbal 502 is not disposed between the load cell and the contact pin 401*. In Fig. 4A, the gimbal is integrated with the contact pin 401, and therefore *there is not any gap supported by the gimbal is existed between the contact pin 401 and the load cell*.

In addition, Trojan fails to teach or suggest that the head component has a heating plate therein. The office action also agrees Trojan does not describe the head component further comprises a heating plate. Therefore, Trojan does not teach or suggest each or every element in claim 1.

For at least the foregoing reasons, Applicant respectfully submits that independent claim 1 patently defines over the prior art reference, and should be allowed. For at least the same reasons, dependent claims 2-4, 9 patently define over the prior art as a matter of law, for at least the reason that these dependent claims contain all features of their respective independent claim.

**Rejection under 35 U.S.C 103 (a)**

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*Applicants respectfully traverse the rejection of claims 5-8 under 103(a) as being unpatentable over Trojan et al. (US 5,899,798) in view of Luse (U.S. 6,486,660) because a prima facie case of obviousness has not been established by the Office Action.*

To establish a prima facie case of obviousness under 35 U.S.C. 103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. 2143, 8<sup>th</sup> ed., February 2003.

Applicant submits that, as disclosed above, Trojan fails to teach or suggest each and every element of claim 1, from which claims 5-8 depend. Luse also fails to teach the gimbal is disposed between the loading component and the head component. Luse cannot cure this deficiency of Trojan.

In addition, the office action pointed out Trojan does not describe the head component further comprises a heating plate, however Luse describes in Fig. 5 a pair of heating plates to provide a thermoelectric source to melt the adhesive or heat the components when quicker bonding is desired. However, applicant submits the combination of the two references made by the office action is not proper. This is because the Luse reference relates to a head testing apparatus for testing a data recording head, and the apparatus shown in Fig. 5 is a distal end of a

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base slide used in a recording head tester. But the Trojan reference is related to an apparatus for a chemical mechanical polishing process. The field of the two references is much different from each other. In addition, the apparatus of Trojan is for improving uniformity in planarity among the substrates, but the objective of Luse is for providing an apparatus having an improved structure for cycling the operating temperature of the head being tested. The purpose of the two references is quite different. Therefore, *there is not any "suggestion, teaching, or motivation" that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed.* In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention (*Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385 (Fed. Cir. 2001)). In particular, when prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself (*Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985)).

For at least the foregoing reasons, a prima facie case of obviousness has not been established by the Office Action. Applicant respectfully submits that independent claim 1 patently defines over the prior art references, and should be allowed. For at least the same reasons, dependent claims 5-8 patently define over the prior art as a matter of law.

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**CONCLUSION**

For at least the foregoing reasons, it is believed that the pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,

  
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